

15 MAY 2003



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In re Application of
APPLEYARD, Steven, Philips et al
U.S. Application No.: 10/019,625
PCT Application No.: PCT/GB00/02363
Filing Date: 03 July 2000
Priority Date: 01 July 1999
Attorney's Docket No.: 50055/1
For: HIGHLY ORIENTED MESOPHASE
PITCH-BASED GRAPHITE TAPE AND
BULK CARBON MATERIAL

DECISION

This decision is in response to applicants' "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(B)" filed 12 March 2003. This has been treated first as a petition to withdraw the holding of abandonment and then as a petition to revive under 37 CFR 1.137(b).

BACKGROUND

On 12 March 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 indicating that an oath/declaration in compliance with 37 CFR 1.497 and a surcharge fee of \$65.00 for providing the oath or declaration later than thirty months from the priority date as required by 37 CFR 1.492(e) must be provided. A two-month period from the date of mailing was set for response. Extensions of time were available.

On 30 April 2002, applicants purportedly filed a response to the Notification of Missing Requirements.

On 13 January 2003, the DO/EO/US mailed a Notification of Abandonment stating that the above-captioned application was abandoned because applicants failed to respond to the Notification of Missing Requirements within the time period set.

On 12 March 2003, applicants filed the instant petition which was accompanied by, *inter alia*, a copy documents purportedly filed 30 April 2002 including an executed declaration, and a copy of a check in the amount of \$475.00 to the USPTO.

DISCUSSION**Petition to Withdraw Holding of Abandonment**

In the instant petition, applicants claim that "a Response to the Notice to File Missing Parts of Application was filed along with other related documents" on 30 April 2002. A review of the above-captioned application reveal that the purported response mailed 30 April 2002 was not located in the file. However, a review of USPTO financial records show that the surcharge fee of \$65.00 was paid on 30 April 2002 along with other fees including additional claim and multiple dependent fees totaling \$475.00.

Nevertheless, the Office has established a practice of providing a receipt for papers filed in the Office to any applicant desiring a receipt. The practice, long-established, requires that any paper for which a receipt is desired be filed in the Office with a self-addressed postcard identifying the paper. Section 503 of the Manual of Patent Examining Procedure allows for a postcard receipt to serve as *prima facie* evidence of receipt in the Office of all the items listed thereon on the date stamped thereon by the Office if the receipt properly identifies the papers which are being filed.

Here, applicants have provided a copy of a postcard receipt allegedly showing that a response was mailed on 30 April 2002. This postcard indicates that a declaration was filed with the instant response. However, the postcard receipt is not date-stamped as received by the USPTO on 30 April 2002. Therefore, the postcard receipt is not considered *prima facie* evidence that a timely response was mailed. The fact that the \$475.00 in fees were received is not dispositive.

Petition to Revive

In the instant petition, applicants request "revival of this unintentionally abandoned application." A petition to revive an application on the grounds of unintentional delay pursuant to 37 CFR 1.137(b) must be accompanied by: (1) a proper reply; (2) the requisite petition fee; (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any required terminal disclaimer.

Applicants have submitted authorization to charge the petition to revive fee of \$650.00 to Deposit Account No. 50-2375 satisfying item (2) of 37 CFR 1.137(b). Regarding item (3), applicants state that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3). No terminal disclaimer is required here so item (4) is satisfied.

A proper reply in the above-captioned application which would satisfy item (1) of 37 CFR 1.137(b) is to provide a declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee pursuant to 37 CFR 1.492(e) in response to the Notification of Missing Requirements Under 35 U.S.C. 371 mailed 12 March 2002. As previously indicated, the surcharge fee of \$65.00 has been received. But a review of the declaration filed with the instant petition reveals that it is not in compliance with 37 CFR 1.497(a) and (b). Applicants submitted what appears to be one complete declaration and two partial declarations. (Applicants provided a declaration consisting of one Page 1 of 3, one Page 2 of 3, and three Page 3 of 3). Applicants must submit a complete copy of each of the declarations signed by each of the applicants. For this reason, item (1) of 37 CFR 1.137(b) is not yet satisfied.

It is also noted that if the declaration was not accompanied by a copy of the application, the declaration would not be considered to properly identify the application. The PCT international number and international filing date should be listed on the first page of the declaration. If applicants resubmit the original declaration as a response, another copy of the application must accompany the declaration. If applicants provide a new declaration, this error should be corrected.

CONCLUSION

For the reasons discussed above, applicants' petition to withdraw the holding of abandonment and petition under 37 CFR 1.137(b) are both DISMISSED without prejudice. The above-captioned application remains ABANDONED.

If reconsideration on the merits of either petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Applicants are advised that the correspondence address has changed. Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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